

**REMARKS**

By the foregoing amendments, Applicant has revised claims 2 to 6, 10 to 12, 17, 18, 33, 45, 56 and 57 to define Applicant's contribution to this art with more precision. In addition, Applicant has rewritten independent claims 1, 9, 14 and 53 as new claims 59 to 62 in order to improve the readability of the claims. No new matter has been added.

Following these amendments, claims 2 to 8, 10 to 13, 17, 18, 33 to 43, 45 to 52, 56, 57 and 59 to 62 are pending in the application, of which claims 33, 45, 59, 60, 61 and 62 are independent claims. Favorable reconsideration and further examination are respectfully requested.

A. **Telephone Conference with the Examiner**

Applicant's representatives appreciate the courtesies extended by Examiner Akiba Robinson-Boyce in granting and conducting a telephone conference on January 30, 2006. During the telephone conference, Applicant's representatives and the Examiner discussed the scope and content of the Saxe reference (U.S. Patent No. 5,636,346) as it pertains to the claim rejections set forth in the Advisory Action.

1. **Claim Rejection under §103(a)**

First, Applicant's representatives and the Examiner discussed the rejection of independent claim 1 under 35 U.S.C. §103(a) as allegedly being obvious over Saxe in view of Heinly ("NAHB Conferees Explore Strategies to Cope with Market Revolution"). Although Applicant has replaced claim 1 with new claim 59 for the sake of clarity, the §103 issues remain the same. As Applicant's independent claim 1 did, claim 59 defines a method for generating a targeted list of prospective customers for a first list purchaser. The method uses a computer system to identify, in a database of prospect lists, at least one prospect list that the database associates 1) with the first list purchaser and 2) with data indicating that the first list purchaser reported a successful use of that prospect list. As a

result, the method forms a first list group of which each member is a prospect list thus identified. The method also identifies at least one *other* list purchaser as indicated by the data to have reported a successful use of a list in the first list group. For each of these *other* list purchasers, the method identifies one or more prospect lists of which a successful use is indicated by the data to have been reported by that *other* list purchaser. Accordingly, the method provides the first list purchaser access to a targeted list of prospective customers drawn from among a second list group consisting of at least one prospect list thus identified.

During the telephone conference Applicant's representatives explained how this subject matter differs from what the Saxe reference describes. Saxe is directed generally to an advertising system that uses a list of American Express cardholders to "generate an American Express cardholder profile" (col. 11, lines 15-20). Subsequently, Saxe matches the cardholder profile with "a list of consumers having generally similar characteristics" in order to generate "a list of non-cardholding individuals having cardholder-type profiles" (col. 11, lines 15-25). The list of cardholders and the list of non-cardholding individuals are matched to a list of cable subscribers in the Chicago region to yield two groups: 1) a list of non-cardholding cable subscribers who live in the Chicago region and can be targeted with American Express card offers; and 2) a list of cable subscribers in the Chicago region who already have an American Express card and can be targeted with premium gold card offers. Saxe generates both of these lists by examining the *contents* of the cardholder profile, such as the region and income levels.

Applicant's representatives pointed out to the Examiner that neither the Saxe nor the Heinly reference suggests identifying, as claim 59 now puts it, "at least one *other* list purchaser indicated by the data to have reported a successful use of a list in the first list group," and, for each such *other* list purchaser, identifying "one or more prospect lists of which a successful use is indicated by the data to have been reported by that *other* list purchaser" (emphasis added). Rather, Saxe identifies a list of American Express cardholders and targets essentially this same group with premium upgrades; or

alternatively, Saxe targets a list of non-cardholding consumers whose characteristics matched those of American Express cardholders.

The understanding of Applicant's representatives is that the Examiner thereupon appreciated the distinction between claim 1's (now claim 59's) subject matter and the prior art of record. Although the Examiner reserved final judgment on the claim's allowability pending review of this response, the foregoing remarks demonstrate that claim 59 defines patentable subject matter.

Claims 2 to 8 depend from claim 59 and are allowable based at least upon their dependency. Similar to claim 59, independent claims 60, 61 and 62 are computer-readable storage medium, system and computer system claims that closely track the language of claim 59. Each of these claims is directed to, *inter alia*, identifying "at least one *other* list purchaser indicated by the data to have reported a successful use of a list in the first list group," and, for each such *other* list purchaser, identifying "one or more prospect lists of which a successful use is indicated by the data to have been reported by that *other* list purchaser" (emphasis added). Accordingly, claims 60, 61 and 62 are allowable for at least the same reason as claim 59. Claims 10 to 13, 17, 18, 56 and 57 depend from at least one of claims 60, 61 and 62, and are allowable based at least upon their dependency.

Although Applicant's representatives did not separately discuss with the Examiner independent claim 33, that claim is allowable for reasons related to, but slightly different from, those given above. Claim 33 recites, *inter alia*, identifying "at least one other prospect list that includes at least one of the prospective customers *included in the successful list* of prospective customers for the first list purchaser," and providing the first purchaser access to "a targeted list including at least one of the prospective customers from the at least one other prospect list." Neither the Saxe nor the Heinly reference suggests identifying another prospect list that includes "at least one of the prospective customers included in the successful list of prospective customers for the first list purchaser." As discussed above, Saxe identifies a list of non-cardholding consumers by matching "consumers having generally similar characteristics" with the cardholder profiles; or

alternatively, Saxe narrows the pre-existing list of American Express cardholders to identify candidates for the premium gold cards (col. 11, 15-25). Accordingly, claim 33 is patentable over Saxe and Heinly and is in condition for allowance. Claims 34 to 44 depend from claim 33 and are allowable based at least upon their dependency.

Similar to claim 33, independent claim 45 is a computer-readable storage medium claim that contains language that closely tracks claim 33. Accordingly, claim 45 is allowable for at least the same reason as claim 33. Claims 46 to 52 depend from claim 45 and are allowable based at least upon their dependency.

B. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully submits that the application is in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicant hereby requests any necessary extension of time. Please charge any deficiency to Deposit Account No. 06-1448, reference NMC-003.01. Applicant's undersigned attorney can be reached at the address shown below. All telephone calls should be directed to the undersigned at 617-832-1257.

Respectfully submitted,



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